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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,622	12/12/2001	Paul F. Laeseke	1512.211	5043
72088 7590 02/11/2009 WISCONSIN ALUMNI RESEARCH FOUNDATION C/O BOYLE FREDRICKSON S.C 840 North Plankinton Avenue Milwaukee, WI 53203				
			EXAMINER SZMAL, BRIAN SCOTT	
			ART UNIT 3736	PAPER NUMBER
			NOTIFICATION DATE 02/11/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

Office Action Summary

Application No.

10/021,622

Applicant(s)

LAESEKE ET AL.

Examiner

Brian Szmaj

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Action after BPAI Decision

1. The BPAI decision filed August 14, 2008 affirmed the Examiner in part by overturning the rejection of Claim 1 and upholding the rejection of Claim 10. The Amendment filed on September 18, 2008 was submitted in order to overcome the rejection of Claim 10, which was upheld by the Board. However, upon a final review by the Examiner, new prior art of Wood (2003/0093007 A1) and Edwards et al (5,935,123) was found that read on the current claims, as outlined below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5, 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al (5,935,123) in view of Balbierz (6,770,070 B1).

Edwards et al disclose an apparatus with a removable radio frequency cauterization device and further disclose an introducer shaft (20) having a first and second end, and sized for percutaneous insertion into a patient along an discloses path to locate the first end at a site, the first end having an electrically conductive surface (16) adapted to be exposed to tissue and communicating by means of an insulated conductor to the second end to connect with a radio frequency cauterizing electrical source (see Column 6, lines 61-63); a large area electrode adapted to contact the

patient without production of cauterizing temperatures to complete a circuit through the radio frequency cauterizing electrical source with the electrically conductive surface of the introducer shaft through a patient (see Column 15, lines 25-27); the electrically conductive surface is a conductive stylet (16) having a first end supported by the introducer shaft (20); the introducer shaft (20) is a hollow tube and wherein the insulated conductor is provided by a portion of the conductive stylet (16) fitting within the hollow tube (see Figure 1b); a shaft portion of the conductive stylet (16) includes an outer insulating cover (20) to provide the insulated conductor; and a temperature sensor (24) positioned at the electrically conductive surface (see Column 11, lines 4-8).

Edwards et al however do not disclose the placement of a biopsy needle through the introducer shaft to perform a biopsy.

Balbierz discloses a lung treatment apparatus and further discloses the placement of a biopsy needle through the introducer shaft to perform a biopsy. See Figures 5a-5c.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the means of Edwards et al to include the use of a biopsy needle, as per the teachings of Balbierz, since it would provide a means of acquiring a biopsy sample through the introducer lumen prior to treating the tissue.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al (5,935,123) in view of Balbierz (6,770,070 B1) as applied to claim 5 above, and further in view of Lennox (5,122,137).

Edwards et al and Balbierz, as discussed above, disclose a biopsy needle assembly, but fail to disclose the conductive stylet has a rounded tip.

Lennox discloses a temperature controlled RF device and further discloses the conductive stylet has a rounded tip. See Figures 1 and 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Edwards et al and Balbierz to utilize a conductive stylet that has a rounded tip, as per the teachings of Lennox, since an RF cutting tip on a stylet can be rounded since the cutting action or the electrocoagulation is performed via the application of RF energy and not the shape of the tip.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmal whose telephone number is (571)272-4733. The examiner can normally be reached on Monday-Friday, with second Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian Szmal/
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736